

### **REMARKS**

The Office Action dated March 30, 2007, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-3, 5-21, 23-36, 45-47, and 49-69 are currently pending in the application, of which claims 1, 19, 45, 60, and 65-66 are independent claims. Claims 1, 5, 8-9, 11, 19, 23-24, 26-27, 29, 45, 49, 52-53, 55, 60-61, and 65-66 have been amended, and claims 67-69 have been added, to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 4, 22, 37-44, and 48 have been canceled without prejudice or disclaimer. Claims 1-3, 5-21, 23-36, 45-47, and 49-69 are respectfully submitted for consideration.

Claims 1-2, 4-5, 8-9, 11-20, 22-23, 26-27, 29-38, 40-46, 48-49, 52-53, 55-60, and 65-66 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0092272 of Valloppillil ("Valloppillil") in view of U.S. Patent Application Publication No. 2003/0027572 of Karlsson et al. ("Karlsson"). Claims 4, 22, 37-38, 40-44, and 48 have been canceled without prejudice or disclaimer. Accordingly, the rejection of claims 4, 22, 37-38, 40-44, and 48 is moot and should be withdrawn. The Office Action took the position with respect to the independent claims, that Valloppillil discloses all of the features of the claims, except "wherein the message comprises roaming information about the user equipment." In addition, with respect to claim 4, the subject matter of which has been incorporated into all of the presently

pending independent claims, the Office Action took the position that Valloppillil failed to disclose the future recitations of the claim. Accordingly, to remedy these and other deficiencies of Valloppillil (with respect to other dependent claims), the Office Action cited Karlsson. Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the combination of Valloppillil and Karlsson.

Claim 1, upon which claims 2-3, 5-18, and 67 depend, is directed to an apparatus including a first system entity configured to provide a multimedia messaging service to user equipment connected to a network of a system. The apparatus also includes a second system entity configured to provide a value added service to a user of the user equipment via the multimedia messaging service. The first system entity is configured to send a message to the second system entity. The message includes roaming information about the user equipment. The second system entity is configured to use the roaming information when providing the value added service to the user equipment.

Claim 19, upon which claims 20-21, 23-36, 61-62, and 68 depend, is directed to a method for providing a multimedia messaging service in a telecommunications system comprising a first system entity configured to provide multimedia messaging service to a user equipment connected to a network of the system, and a second system entity configured to provide a value added service to a user of the user equipment via the multimedia messaging service. The method includes sending a message from the first system entity to the second system entity. The message comprises roaming information

about the user equipment. The method also includes using the roaming information when providing the value added service to the user equipment.

Claim 45, upon which claims 46-47, 49-59, 63-64, and 69 depend, is directed to a value added service providing element configured to provide a value added service to a user of user equipment connected to a network via a multimedia messaging service that is provided by a multimedia messaging service providing system entity. The value added service providing element is also configured to receive a message from the multimedia messaging service providing system entity, wherein the message comprises roaming information about the user equipment. The value added service providing element is further configured to use the roaming information when providing the value added service to the user equipment.

Claim 60 is directed to a computer-readable storage medium comprising a computer program set, wherein the execution of the program set in a computer connected to a telecommunications system causes the computer to execute providing a value added service to a user of user equipment connected to a network of a telecommunications system via a multimedia messaging service that is provided by a multimedia messaging service providing system entity. The execution of the program set also causes the computer to execute receiving a message from the multimedia messaging service providing system entity, wherein the message comprises roaming information about the user equipment. The execution of the program set further causes the computer to execute

using the roaming information when providing the value added service to the user equipment.

Claim 65 is directed to a system including a first system entity means for providing multimedia messaging service to a user equipment connected to a network of the system. The system also includes a second system entity means for providing a value added service to a user of the user equipment via the multimedia messaging service. The system further includes sending means for sending a message from the first system entity means to the second system entity means, wherein the message comprises roaming information about user equipment. The second system entity means is configured to use the roaming information when providing the value added service to the user equipment.

Claim 66 is directed to a method including providing a multimedia messaging service to user equipment connected to a network of a system. The method also includes providing a value added service to a user of the user equipment via the multimedia messaging service. The method further includes sending a message from a first system entity to a second system entity, wherein the message comprises roaming information about the user equipment. The method additionally includes using the roaming information when providing the value added service to the user equipment.

As explained at paragraph [0008] of the present application, certain embodiments of the present invention can advantageously produce a value added service dependently or conditionally on roaming information. Thus, with knowledge that the user equipment

is roaming, the content can be adapted such that, for example, the transfer time and hence costs incurred are reduced.

Applicants respectfully submit that the combination of Valloppillil and Karlsson fails to disclose or suggest all of the features of any of the presently pending claims, and consequently cannot provide the critical and non-obvious advantages discussed above.

Valloppillil generally relates to an asynchronous messaging based system for publishing and accessing content and accessing applications on a network with mobile devices. As explained at paragraph [0013] thereof, Valloppillil aims to provide a powerful way for wireless subscribers to publish and access many types of content from their mobile devices, in a manner that is user friendly, so as to encourage use, and that provides wireless carriers with an efficient way to derive revenue.

Claim 1 recites, in part, “wherein the first system entity is configured to send a message to the second system entity.” Valloppillil fails to disclose or suggest at least this feature of claim 1.

The Office Action took the position that Valloppillil discloses this feature of claim 1 at paragraphs [0066] and [0101]. Applicants respectfully disagree. Valloppillil does not disclose or suggest that a first system entity, configured to provide a multimedia messaging service, would be configured to send a message to a second system entity, configured to provide a value added service.

In the Office Action’s comparison, as best understood, Valloppillil’s first system entity (*i.e.* the entity that provides a multimedia messaging service) is the MMSC 4.

Neither paragraph [0066] or [0101] of Valloppillil (cited by the Office Action) discloses the MMSC 4 sending any message to any other entity, unless it is to be understood that the Office Action's assertion is that the user 1 sending a message such as "\*\*save" to the MMS publishing system 7 constitutes the claimed recitation. Such a correlation would be improper, because the claim recites that the first system entity provides the multimedia messaging service "to user equipment," which distinguishes the first system entity from the user equipment. Accordingly, Valloppillil is deficient at least with respect to this feature of claim 1.

In addition, the Office Action admitted that Valloppillil fails to disclose or suggest "wherein the message comprises roaming information about the user equipment," as recited in claim 1. Likewise, at pages 4-5, the Office Action implicitly admitted that Valloppillil fails to disclose or suggest "wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment," as previously recited in claim 4, and as presently recited in claim 1.

The Office Action cited Karlsson to remedy the latter two deficiencies of Valloppillil with respect to claim 1 (and former claim 4). Karlsson fails to remedy these or the additional deficiencies noted above, and consequently the combination of Valloppillil and Karlsson fails to disclose or suggest all of the elements of any of the presently pending claims.

Karlsson generally relates to a method and system for primary paging location of a mobile terminal. As discussed at paragraph [0015] thereof, Karlsson aims to provide a

way to reduce the amount of congestion within a service area due to global pages after an MSC/VLR system restart and reload. More particularly, Karlsson aims to provide a way to store additional area information of the mobile terminal so that the information can be restored when such a system restart and reload occurs.

Karlsson, however, is entirely silent with respect to multimedia messaging service or entities configured to provide such service. Likewise, Karlsson does not disclose anything about any kind of value added service or entities configured to provide value added service. In particular, Karlsson discloses nothing at all about the provision of value added service to a user of user equipment via a multimedia messaging service.

At paragraph [0048], Karlsson indicates that “the MSC-A/VLR 102A sends an update subscriber data message that includes the new roaming area information 204 of the mobile terminal 110 to the HLR/GLR 108.” It should be noted, however, that neither is the MSC-A/VLR a multimedia messaging service entity, nor is the HLR/GLR a value added service entity.

As noted above, Valloppillil fails to disclose or suggest, “wherein the first system entity is configured to send a message to the second system entity,” as recited in claim 1. As noted above, because Karlsson does not disclose an entity configured to provide a multimedia messaging service or an entity configured to provide a value added service, Karlsson cannot remedy the deficiency of Valloppillil with respect to this feature of claim 1.

For similar reasons, because Karlsson does not disclose any such message being sent or such entities being present in the communication system, Karlsson cannot disclose or suggest “wherein the message comprises roaming information about the user equipment,” or “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment,” as recited in claim 1.

The Office Action took the position that the former feature of claim 1, “wherein the message comprises roaming information about the user equipment,” is disclosed by Karlsson at paragraphs [0035] and [0048]. The cited passages, however, merely deal with the transfer of roaming information between the MSC and HLR, as discussed above taking paragraph [0048] as an example.

The Office Action took the position that it would have been obvious to modify the message of Valloppillil to including the roaming information, “in order to reduce paging congestion in the network,” citing the abstract of Karlsson. However, simply adding roaming information to messages in general is not what is alleged by Karlsson to provide the benefit of reducing paging congestion. Indeed, one of ordinary skill in the art would not have a reasonable expectation of success of reducing paging congestion in the network of Valloppillil by adding roaming information to, for example, the “\*send” message described at paragraph [0066] of Valloppillil.

Furthermore, one of ordinary skill in the art would not have found motivation in Karlsson’s disclosure to add the roaming information to any other message than the



update subscriber data message, as proposed by Karlsson. Accordingly, one of ordinary skill in the art would find no teaching, motivation, suggestion, or other reason to modify Valloppillil so as to correspond to what is claimed, even in view of the combined teachings of Valloppillil and Karlsson.

Turning to the latter admitted deficiency of Valloppillil with respect to claim 1, “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment,” an even more severe deficiency in Karlsson becomes apparent.

As noted above, Karlsson does not make any mention of value added service. The Office Action cited paragraph [0035] of Karlsson as disclosing “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment,” as recited in claim 1. The cited passage, however, discloses no such thing.

The cited passage mentions roaming information, but only discusses that the roaming information is sent and stored. The cited passage does not mention a value added service, and the cited passage certainly does not mention that the roaming information is to be used when providing valued added service to a user equipment. Accordingly, Karlsson cannot remedy Valloppillil’s admitted deficiencies with respect to at least this feature of claim 1.

Additionally, the Office Action does not provide any teaching, motivation, suggestion, or other reason why one of ordinary skill in the art would have combined

Valloppillil and Karlsson to provide this feature. The motivation identified above with respect to reducing paging congestion cannot reasonably be applied to this feature of the claim, and, thus, the rejection clearly fails to serve as a *prima facie* obviousness rejection.

MPEP 2142 explains that, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to modify the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all of the claim limitations. Because there is no teaching, motivation, suggestion, or other reason to combine the references (especially with regard to the particular features identified above), because the combination of references fails to disclose or suggest all of the elements of any of the presently pending claims, and because one of ordinary skill in the art would not have a reasonable expectation of success in obtaining the alleged goals proposed in the Office Action by means of the modifications required to make Valloppillil's system correspond to what is claimed, Applicants respectfully submit that the Office Action has failed to provide a *prima facie* case of obviousness. It is, therefore respectfully requested that the rejection of claim 1 be withdrawn.

Independent claims 19, 45, 60, and 65-66 each have their own scope, but each recite at least some of the features discussed above, with respect to which the combination of Valloppillil and Karlsson is deficient, and these independent claims were not separately rejected. Accordingly, it is respectfully submitted that claims 19, 45, 60,

and 65-66 are likewise patentable over the combination of Valloppillil and Karlsson, and it is respectfully requested that the rejection of claims 19, 45, 60, and 65-66 be withdrawn.

Claims 2, 5, 8-9, 11-18, 20, 23, 26-27, 29-36, 46, 49, 52-53, and 55-59 depend respectively from, and further limit, claims 1, 19, and 45. Claims 2, 5, 8-9, 11-18, 20, 23, 26-27, 29-36, 46, 49, 52-53, and 55-59, therefore, each recite subject matter that is neither disclosed nor suggested in the combination of Valloppillil and Karlsson. Thus, it is respectfully requested that the rejection of claims 2, 5, 8-9, 11-18, 20, 23, 26-27, 29-36, 46, 49, 52-53, and 55-59 be withdrawn.

Claims 6-7, 24-25, 50-51, and 61-64 were rejected under 35 U.S.C. 103(a) as being unpatentable over Valloppillil in view of Karlsson and further in view of U.S. Patent Application Publication No. 2003/0193967 of Fenton et al. ("Fenton"). The Office Action took the position that the combination of Valloppillil and Karlsson discloses most of the features of the claims, but cited Fenton to remedy certain further limitations of the claims. Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the combination of Valloppillil, Karlsson, and Fenton.

Claims 6-7, 24-25, 50-51, and 61-64 depend respectively from, and further limit, claims 1, 19, and 45. At least some of the deficiencies of claims the combination of Valloppillil and Karlsson with respect to claims 1, 19, and 45 are discussed above. Fenton does not remedy the above-identified deficiencies of Valloppillil and Karlsson,

and consequently the combination of Valloppillil, Karlsson, and Fenton fails to disclose or suggest all of the elements of any of the presently pending claims.

Fenton generally relates to a method, apparatus, and system for processing multimedia messages. As explained at paragraphs [0003] to [0007] thereof, Fenton aims to provide a method, apparatus, and system that process multimedia messages and is capable of supporting current and future multimedia messaging services, as well as to exploit the advances being made in the world multimedia community, with additional mobile requirements. Accordingly, it is unsurprising that Fenton fails to remedy the above-identified deficiencies of the combination of Valloppillil and Karlsson.

Thus, it is respectfully submitted that the combination of Valloppillil, Karlsson, and Fenton fails to disclose or suggest all of the elements of claims 6-7, 24-25, 50-51, and 61-64, and it is respectfully requested that the rejection of claims 6-7, 24-25, 50-51, and 61-64 be withdrawn.

Claims 3, 10, 21, 28, 39, 47, and 54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Valloppilli in view of Karlsson and further in view of U.S. Patent No. 6,917,813 of Elizondo (“Elizondo”). The Office Action took the position that the combination of Valloppillil and Karlsson discloses most of the features of the claims, but cited Elizondo to remedy certain further limitations of the claims. Claim 39 has been canceled without prejudice or disclaimer. Thus, the rejection of claim 39 is moot and should be withdrawn. Applicants respectfully submit that the claims recite subject matter

that is neither disclosed nor suggested in the combination of Valloppillil, Karlsson, and Elizondo.

Claims 3, 10, 21, 28, 47, and 54 depend respectively from, and further limit, claims 1, 19, and 45. At least some of the deficiencies of claims the combination of Valloppillil and Karlsson with respect to claims 1, 19, and 45 are discussed above. Elizondo does not remedy the above-identified deficiencies of Valloppillil and Karlsson, and consequently the combination of Valloppillil, Karlsson, and Elizondo fails to disclose or suggest all of the elements of any of the presently pending claims.

Elizondo generally relates to provision of short message services. As explained at column 2, lines 47-56, thereof, Elizondo aims to provide a method that allows the HLR to determine the proper address for the MSC (or VLR) serving a roaming MS, when requested by an external node, while enabling communication between the external node and the MS, MSC, or VLR, so as to provide proper addressing of SMS services to MSs roaming in an SS7 network that is different from the MS home network, when SMS reception from SS7 networks is not being used by the MS. Accordingly, it is unsurprising that Elizondo fails to remedy the above-identified deficiencies of the combination of Valloppillil and Karlsson.

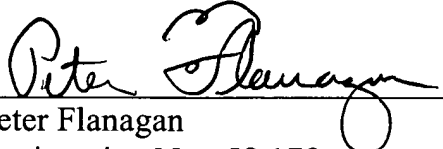
Thus, it is respectfully submitted that the combination of Valloppillil, Karlsson, and Elizondo fails to disclose or suggest all of the elements of claims 3, 10, 21, 28, 47, and 54, and it is respectfully requested that the rejection of claims 3, 10, 21, 28, 47, and 54 be withdrawn.

For all the reasons above, it is respectfully submitted that each of claims 1-3, 5-21, 23-36, 45-47, and 49-69 recites subject matter that is neither disclosed nor suggested in the prior art. It is, therefore, respectfully requested that all of claims 1-3, 5-21, 23-36, 45-47, and 49-69 be allowed, and that this application be passed to issue.

If, for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

  
Peter Flanagan  
Registration No. 58,178

**Customer No. 32294**  
SQUIRE, SANDERS & DEMPSEY LLP  
14<sup>TH</sup> Floor  
8000 Towers Crescent Drive  
Tysons Corner, Virginia 22182-2700  
Telephone: 703-720-7800  
Fax: 703-720-7802

PCF:kzw:kh